

REMARKS

The Applicant submits this Amendment in response to the non-final Office Action mailed May 30, 2002. Claims 23-57 are pending in the Application. Claims 23, 30-35, 40, 42-46, 50, and 53-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,450,079 to Dunaway (hereinafter "Dunaway") in view of U.S. Patent No. 5,506,605 to Paley (hereinafter "Paley"). Claims 24-27, 36-39, and 47-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunaway in view of Paley and further in view of U.S. Patent No. 4,712,101 to Culver (hereinafter "Culver"). Claims 29, 41, and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunaway in view of Paley and further in view of U.S. Patent No. 6,184,862 to Leiper (hereinafter "Leiper"). The Applicant respectfully traverses these rejections.

The Applicant has amended claims 23-34, canceled claims 35-57 without prejudice or disclaimer, and added new claim 58. The amendments to the pending claims have not been made to overcome the art cited by the Office Action. Rather, the amendments have been made to delete unnecessary terms and to clarify and broaden the pending claims consistent with the written description. These amendments are discussed in further detail below, and support for these amendments can be found in the specification and original claims. No new matter has been inserted. The Applicant respectfully submits that the pending claims are patentable. Consideration of the pending claims is respectfully requested in view of the foregoing and the following remarks.

A. Claims 23, 28, 30-34

The Office Action rejected claims 23, 28, 30-34 under 35 U.S.C. § 103(a) as being unpatentable over Dunaway in view of Paley. The Applicant respectfully traverses these rejections for the following reasons.

The rejection is improper because there is no suggestion or motivation to combine the references to result in Applicant's invention. One of the criteria for a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings.” MPEP § 2143. The Office Action asserts that “[i]t would have been obvious to one of ordinary skill in the art to have modified Dunaway with the features of tactile feedback as taught by Paley because the tactile feedback can enhance its usefulness in various application[s] (col. 2, lines 2-5).” The general assertion that “tactile feedback can enhance ... usefulness,” while a very general statement of motivation, is not a showing of the necessary suggestion or motivation *to modify Dunaway or to combine Dunaway and Paley*.

“The teaching or suggestion to make the claimed combination *and the reasonable expectation of success* must be found in the prior art, not in applicant’s own disclosure.” MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d (Fed. Cir. 1991) (emphasis added)). No teaching or suggestion to combine Dunaway and Paley, nor any grounds for a reasonable expectation of success in combination, has been shown. The references show no recognition of, or pertinence to, enhancing device functionality by providing tactile feedback to a control device *to result in the invention claimed*. Thus, the Office has not established a *prima facie* case of obviousness.

Therefore, independent claim 23 is patentable over Dunaway in view of Paley. Accordingly, the rejection to claim 23 should be withdrawn. Claims 28 and 30-34 depend ultimately from independent claim 23 and are, therefore, also allowable for at least the same reasons as claim 23.

B. Claims 24-27

The Office Action rejected claims 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Dunaway in view of Paley and further in view of Culver. Claims 24-27 depend ultimately from claim 23. As discussed above, independent claim 23 is patentable over Dunaway in view of Paley. Irrespective of the additional ground of rejection cited against dependent claims 24-27, these claims are allowable since they each depend upon an allowable independent base claim. Accordingly, the rejections to claims 24-27 should be withdrawn. Thus, claims 24-27 are allowable.

C. Claim 29

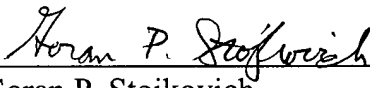
The Office Action rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Dunaway in view of Paley and further in view of Leiper. Claim 29 depends ultimately from claim 23. As discussed above, independent claim 23 is patentable over Dunaway in view of Paley. Irrespective of the additional ground of rejection cited against dependent claim 29, this claim is allowable since it depends upon an allowable independent base claim. Accordingly, the rejection to claim 29 should be withdrawn. Thus, claim 29 is allowable.

CONCLUSION

The Applicant respectfully submits that claims 23-34 and 58 are allowable. A favorable Office Action is respectfully solicited. The Examiner is invited to contact the undersigned by telephone to discuss any matter related to the Application.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE**Amendments in the Claims:**

In accordance with 37 C.F.R. § 1.121(b), the following replacement claims show all the changes made by the foregoing amendments relative to the previous version of the claims. Material added is shown in **underlined text** and material deleted is shown in **[brackets]**.

23. (Amended) **[A handheld control device for interfacing with a host processor, said control device]** **An apparatus** comprising:

[a housing shaped to be held by a user;]

a [moveable user object engageable by a finger of the user and] manipulandum movable in at least one degree of freedom **[with respect to said housing];**

a sensor operative to detect the motion of said [user object] manipulandum [in said degree of freedom] and to output a sensor signal that correlates with a detected motion of said manipulandum;

an actuator operative to provide tactile feedback [to said user of said handheld control device] that correlates with the sensor signal;

[a local display screen mounted on said housing and separate from said host processor, said display screen operative to display textual information related to a program running on the host processor and to assist the user in using the control device;] and

a wireless communication interface operative to [transfer data from the control device to the host processor and from the host processor to the control device] communicate with a host processor.

24. (Amended) **[A handheld control device]** **An apparatus** as recited in claim 23 wherein said **[manipulatable object is] manipulandum comprises** a roller.

25. (Amended) [A handheld control device] An apparatus as recited in claim 24 wherein said roller [can be pressed by said user to trigger] communicates an electrical signal output to said [host processor] wireless communication interface.

26. (Amended) [A handheld control device] An apparatus as recited in claim 24 wherein said roller is moveable in two degrees of freedom.

27. (Amended) [A handheld control device] An apparatus as recited in claim 26 wherein said two degrees of freedom [include] comprise a rotary degree of freedom and a translatory degree of freedom.

28. (Amended) [A handheld control device] An apparatus as recited in claim 23 further comprising [wherein said] a local display screen [has a touch-sensitive surface].

29. (Amended) [A handheld control device] An apparatus as recited in claim 23 further comprising a microphone [for receiving voice commands from said user].

30. (Amended) [A handheld control device] An apparatus as recited in claim 23 wherein said host processor is included in a video game console.

31. (Amended) [A handheld control device] An apparatus as recited in claim 23 wherein said host processor is included in a [personal] computer.

32. (Amended) [A handheld control device] An apparatus as recited in claim 23 wherein said host processor is included in a Web-access device.

33. (Amended) [A handheld control device] An apparatus as recited in claim 23 wherein said host processor is included in [a consumer] an electronic device.

34. (Amended) **[A handheld control device] An apparatus** as recited in claim 23 further comprising a local processor, separate from said host processor and operative to communicate with said host processor[, **to read said sensor, to control said actuator to produce tactile sensations, and to control said local display screen**].